

REMARKS/ARGUMENTS

The preceding amendments and following remarks are submitted in response to the final Office Action mailed June 8, 2005, setting a three-month shortened statutory period for response ending September 8, 2005. With this Amendment, claims 1, 10, 16, and 25 have been amended. Reconsideration, examination and allowance of all pending claims are respectfully requested.

Claim Objections

In paragraph 1 of the Office Action, the Examiner objected to claim 16 as containing the registered trademark "Dacron". In paragraph 8 of the Office Action, the Examiner states that the objection will stand until the claim is cancelled or the mark is replaced with a generic name.

In response to the Examiner's objection, Applicants have amended claim 16 replacing the term "Dacron" with the generic name "a synthetic polyester material", as suggested by the Examiner. Antecedent support for this amendment can be found on page 10, lines 5-8 of the Application. Based on this amendment, Applicants respectfully assert that the objection to claim 16 should be withdrawn.

35 U.S.C. § 102(e) Rejections

In paragraph 3 of the Office Action, the Examiner rejected claims 1-10 and 17-22 under 35 U.S.C. § 102(e) as being anticipated by *Levinson et al.* (U.S. Patent No. 6,277,139). The Examiner states that the frame element "20" disclosed in *Levinson et al.* corresponds to an "actuatable stop" disposed at the distal end of a core wire. In paragraph 8 of the Office Action, the Examiner further states that the expandable frame (20) in *Levinson et al.* acts in a similar manner to that of the claimed stop, and, therefore,

discloses an "actuatable stop". With respect to the filter recited in the claims, the Examiner states that the filter has not been claimed in a manner that would lead one of ordinary skill in the art to come to the conclusion that the filter is a separate element that is slidably disposed on the guidewire until it comes in contact with the claimed stop.

Applicants respectfully assert that the *Levinson et al.* reference does not disclose or suggest the actuatable guidewire recited in claims 1-10 and 17-22. However, in order to move prosecution along in this case, Applicants have amended independent claims 1 and 10 to further recite that the filter is slidably disposed on the core wire proximally of the actuator stop. Claim 1, for example, now recites:

1. (currently amended) An articulating guidewire, comprising:
 - an elongated core wire having a longitudinal axis, a proximal end and a distal end;
 - an actuatable stop disposed at the distal end of said core wire, said actuatable stop moveable between a collapsed position and an expanded position;
 - an actuator coupled to the stop, said actuator moveable between a first position and a second position to move the stop between the collapsed position and the expanded position; and
 - a filter slidably disposed on the core wire proximally of said actuatable stop.

As can be seen above, claim 1 has been amended to now recite that the filter is slidably disposed on the core wire proximally of said actuatable stop. Claim 10 has been amended to similarly recite these limitations. Antecedent support for these amendments can be found on page 6, lines 17-22 and page 8, lines 15-19 of the Specification, and in claim 23 previously considered by the Examiner. Applicants assert that no new matter is introduced into the claims as a result of these amendments.

Unlike the articulating guidewire recited in claims 1 and 10, *Levinson et al.* fails to disclose or suggest an actuatable stop moveable between a collapsed position and an

expanded position, and a filter slidably disposed on the core wire proximally of said actuatable stop. In *Levinson et al.*, the expandable frame (20) that the Examiner considers to be an “actuatable stop” is a part of the filter device (10) that filters emboli contained within the vasculature. See *Levinson et al.* at col. 6, lines 30-31. As discussed in previous amendments, this interpretation is inconsistent with the *Levinson et al.* Specification, which teaches a separate stop (16) for preventing longitudinal movement of the filter device (10) beyond the stop (16). See *Levinson et al.* at col. 6, lines 21-25. In addition, such interpretation is inconsistent with a stated purpose of the device in *Levinson et al.*, which is to permit “the free movement of [the] guide wire 12 within and through filter device 10.” See *Id.* at col. 6, lines 57-60. Thus, since the expandable frame (20) in *Levinson et al.* is not equivalent to an actuatable stop moveable between a collapsed position and an expanded position, Applicants respectfully assert that claims 1 and 10 are not anticipated.

In addition, even assuming *arguendo* that the expandable frame (20) in *Levinson et al.* is an actuatable stop, Applicants assert that the *Levinson et al.* reference nevertheless fails to disclose or suggest each and every element recited in claims 1-10 and 17-22. For example, if the Examiner maintains that the expandable frame (20) of the filter device (10) is an actuatable stop moveable between a collapsed position and an expanded position, then *Levinson et al.* would fail to teach the separate limitation of a “filter slidably disposed on the core wire proximally of said actuatable stop”, as further recited in claims 1 and 10. Thus, irrespective of whether the filter device (10) is construed as an actuatable stop or not, Applicants assert that the *Levinson et al.* reference fails to disclose each and every element of claims 1 and 10.

Because claims 1 and 10 are patentable over the *Levinson et al.* reference, claims 2-9 and 17-22 are also patentable for the reasons stated above, and since they add other significant elements to distinguish them from the cited prior art.

35 U.S.C. § 103(a) Rejections

In paragraph 5 of the Office Action, the Examiner rejected claims 13, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Levinson et al.* (U.S. Patent No. 6,277,139) as applied to claim 10 above, and further in view of *Dubrul et al.* (U.S. Patent No. 6,602,265). Furthermore, in paragraph 6 of the Office Action, the Examiner rejected claims 11-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Levinson et al.* (U.S. Patent No. 6,277,139) as applied to claim 10 above, and further in view of *Tate* (U.S. Patent No. 3,841,308). Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art. See MPEP at § 2143.03. As discussed above, *Levinson et al.* fails to disclose or suggest an actuatable stop moveable between a collapsed position and an expanded position, and a filter slidably disposed on the core wire proximally of said actuatable stop. Likewise, nothing in the *Dubrul et al.* or *Tate* references discloses or suggests these features. Thus, since neither *Levinson et al.*, either individually or in combination with *Dubrul et al.* or *Tate*, disclose or suggest an actuatable stop moveable between a collapsed position and an expanded position, and a filter slidably disposed on the core wire proximally of said actuatable stop, Applicants respectfully assert that claims 11-16 are not obvious over the cited prior art.

In paragraph 7 of the Office Action, the Examiner further rejected claims 23-27 under 35 U.S.C. § 103(a) as being unpatentable over *Cohen et al.* (U.S. Patent No. 5,167,239) in view of *Dubrul et al.* (U.S. Patent No. 6,602,256).

Applicants submit that claims 23-27 are not obvious in view of *Cohen et al.* and *Dubrul et al.* since these references fail to disclose each and every element in the claims.

Independent Claim 23 recites in full:

23. A method for placing an articulating guidewire in the vasculature, comprising the steps of:

- providing an articulating guidewire comprising an elongated core wire having a longitudinal axis, a proximal end and a distal end; and an actuatable stop disposed at the distal end of the core wire, said actuatable stop moveable between a collapsed position and an expanded position;

- inserting the guidewire into the lumen of a blood vessel;

- positioning a distal portion of the guidewire beyond a lesion or other protrusion within the body;

- actuating the actuatable stop from the collapsed position to the expanded position; and

- advancing a filter on the guidewire to the stop.

In contrast to claim 23, neither *Cohen et al.* nor *Dubrul et al.*, either alone or in combination, disclose or suggest a method of placing an articulating guidewire in the vasculature. The *Cohen et al.* reference appears to teach an anchorable guidewire including an inflatable anchoring balloon to facilitate anchoring and holding the guidewire in a particular body passageway. See *Cohen et al.* at col. 3, lines 64-68. *Cohen et al.* suggest that the anchoring balloon facilitates holding the guidewire in place while manipulating or exchanging a catheter, scope or other instrument which has been inserted over the guidewire. See *Cohen et al.* at col. 3, lines 3-23. *Cohen et al.* does not teach, however, the placement of an articulating guidewire having an actuatable stop including the step of actuating the actuatable stop from a collapsed position to an expanded position or the step of advancing a filter on the guidewire to the stop.

Likewise, the *Dubrul et al.* reference fails to teach these claim limitations. *Dubrul et al.* appears to suggest a method of removing tissue from the body using a trapping device (TRAP). Nothing in that reference discloses or suggests the use of an actuatable stop on the distal end of the core wire. In addition, nothing in that reference discloses or suggests the step of advancing a filter on the guidewire to the stop. As such, Applicants assert that the combination of *Cohen et al.* and *Dubrul et al.* fails to teach each and every limitation of claims 23-27.

Additionally, with respect to claims 25-27, Applicants submit that *Cohen et al.* and *Dubrul et al.* fail to disclose or suggest an actuator moveable about a core wire, as further recited in independent claim 25. Thus, the combination of *Cohen et al.* and *Dubrul et al.* fails to teach each and every limitation of claims 25-27.

In addition, Applicants respectfully assert that there is no motivation or suggestion to combine the teachings of *Cohen et al.* with that in *Dubrul et al.* to arrive at the claimed invention. To support a *prima facie* case of obviousness, there must be a suggestion or motivation in the prior art reference to modify the reference or combine the teachings with the knowledge available to one of ordinary skill in the art. See MPEP at § 2142. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

As discussed previously, there is no motivation or suggestion to conclude that the anchoring balloon of *Cohen et al.* is a stop for limiting the distal travel of a filter, as currently claimed. As such, there is no motivation to combine *Dubrul et al.* with that

taught in *Cohen et al.* to arrive at the method of claims 23-27. Therefore, Applicants submit that claims 23-27 are patentable over the cited prior art.

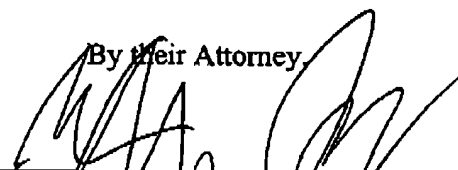
Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney.

Respectfully submitted,

ANTHONY C. VRBA ET AL.

By their Attorney,

Date: July 26, 2005


Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050